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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,844	08/02/2001	Hiroshi Nitta	121.1018/HEW	5683
21171 7590 11/28/2007 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
			EXAMINER VAN BRAMER, JOHN W	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 11/28/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/919,844	<b>Applicant(s)</b> NITTA ET AL.	
	<b>Examiner</b> John Van Bramer	<b>Art Unit</b> 3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 September 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 6-9, 12-15, 18, 19 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-9, 12-15, 18, 19 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. The amendment filed September 14, 2007 cancelled no claims. Claims 1, 7, 13, 19, and 22 have been amended. No new claims were added, thus the currently pending claims are Claims 1-3, 6-9, 12-15, 18, 19, and 22.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 6-9, 12-15, 18, 19, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valentino (U.S. Patent Number: 4,648,037) in view of Kramer et al. (U.S. Patent Number: 6,327,574).

Claim 1: Valentino discloses an information inquiry apparatus that receives an information inquiry from a terminal connected through a communication pathway, comprising:

- a. An inquiry information file that stores the inquiry information for each member of an organization (Col 5, lines 12 – 22; and Col 6, lines 49 – 68)
- b. An inquiry image display generator that generates display data from the inquiry information file so that a display image of the display data contains the inquiry information for the member of the organization. (Col 6, line 49 through Col 7, line 21)
- c. An inquiry information transmitter that receives the information inquiry from the terminal and transmits the inquiry image. (Col 6, line 49 through Col 7, line 21)
- d. A purchase simulator that simulates the member's purchase of the advertising company's product using a simulation database containing products and product prices of the advertising company. (Col 14, line 45 through Col 15, line 23)

The Valentino reference discloses that the information requested by the employee includes such information related to possible choices in their retirement plans, health insurance plans, and flexible benefit plans such as cafeteria plans. While these choices are enticements to purchase the displayed products, and therefore qualify as advertisements, Valentino does not specifically state that these are advertisements in which data is collected regarding the success of the promotion and said data is forwarded to the advertisers in a privacy protected manner. However, the analogous art of Kramer (U.S. Patent Number: 6,327,574), discloses that any structured document may be illuminated

with advertisements (Col 7, lines 45-53; Figs 3A and 3B). An illumination is a piece of targeted content (Col 4, lines 64-67) whereby sections of documents annotated or replaced with targeted content that expands upon the information in the original content and provides a more interesting presentation of the information (Col 6, lines 23-46) including hyperlinks and promotions (Col 7, lines 8-28). The illumination process described by Kramer processes all personal data on the client side (the terminal used by the user) to maintain privacy (Col 11, line 55 –67) and data regarding the success of the promotion such as the number of views is sent to the advertisers server (Col 13, lines 26-53). Therefore, it would have been obvious to one of ordinary skill in the art to use the targeted advertising disclosed by Kramer with the apparatus for benefit and financial communication disclosed by Valentino. One would have been motivated to include such advertising in order to provide an advertisement revenue stream that helps to offset the expense of operating the system disclosed by Valentino.

Claim 2: Valentino and Kramer disclose the information inquiry apparatus in claim 1, further comprising: a confirmation information file that stores confirmation information when the employee submits the information inquiry from the terminal and receives the display image. (Valentino: Col 5, lines 49 – 64 and Col 14, lines 34 – 44)

Claim 3: Valentino and Kramer disclose the information inquiry apparatus in claim 2,

wherein the confirmation information is sent to the organization. (Valentino: Col 5, lines 49 – 64 and Col 14, lines 34 – 44)

Claim 6: Valentino and Kramer disclose the information inquiry apparatus in claim 1, wherein the advertising information includes information tailored to at least one of an employee income level, an employee organizational unit and an employee information input. (Valentino: Col 14, lines 45 – 65)

Claim 7: Valentino discloses an employee information communication method, comprising:

- a. Electronically storing employee information including at least one of employee name, employee company, employee number and employee password. (Col 5, lines 12 – 22; and Col 13, lines 52 – 67)
- b. Electronically storing employee detailed wage information including at least one of employee number, employee company, employee name, payment amounts, deduction amounts and date of payment from a second source. (Col 13, lines 52 – 67)
- c. Receiving an inquiry from an employee. (Col 14, lines 19 – 33)
- d. Generating a detailed wage image that includes employee information and employee detailed wage information. (Col 14, lines 19 – 33)

- e. Simulating the employee's purchase of a product using a simulation database containing products and product prices of the advertising company. (Col 14, line 45 through Col 15, line 23)

The Valentino reference discloses that the information requested by the employee includes such information related to possible choices in their retirement plans, health insurance plans, and flexible benefit plans such as cafeteria plans. While these choices are enticements to purchase the displayed products, and therefore qualify as advertisements, Valentino does not specifically state that these are advertisements in which data is collected regarding the success of the promotion and said data is forwarded to the advertisers in a privacy protected manner. However, the analogous art of Kramer (U.S. Patent Number: 6,327,574), discloses that any structured document may be illuminated with advertisements (Col 7, lines 45-53; Figs 3A and 3B). An illumination is a piece of targeted content (Col 4, lines 64-67) whereby sections of documents annotated or replaced with targeted content that expands upon the information in the original content and provides a more interesting presentation of the information (Col 6, lines 23-46) including hyperlinks and promotions (Col 7, lines 8-28). The illumination process described by Kramer processes all personal data on the client side (the terminal used by the user) to maintain privacy (Col 11, line 55 –67) and data regarding the success of the promotion such as the number of views is sent to the advertisers server (Col 13, lines 26-53). Therefore, it would have been obvious to one of ordinary skill in the art to use the targeted

advertising disclosed by Kramer with the apparatus for benefit and financial communication disclosed by Valentino. One would have been motivated to include such advertising in order to provide an advertisement revenue stream that helps to offset the expense of operating the system disclosed by Valentino.

Claim 8: Valentino and Kramer disclose the employee information communication method in claim 7, further comprising electronically storing confirmation information when the employee submits the inquiry and receives the detailed wage image.  
(Valentino: Col 5, lines 49 – 64; and Col 14, lines 34 – 44)

Claim 9: Valentino and Kramer disclose the employee information communication method in claim 8, further comprising sending the confirmation information to the second source. (Valentino: Col 5, lines 49 – 64; and Col 14, lines 34 – 44)

Claim 12: Valentino and Kramer disclose the employee information communication method in claim 7, wherein the advertising information includes information tailored to at least one of an employee income level, an employee organizational unit and an employee information input. (Valentino: Col 14, lines 45 – 65)

Claim 13: Valentino discloses an employee information communication system, comprising:



- a. A first electronic data storage device that stores employee information including at least one of employee name, employee company, employee number and employee password. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
- b. A third electronic data storage device that stores employee detailed wage information including at least one of employee number, employee company, employee name, payment amounts, deduction amounts and date of payment from a second source. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
- c. An image generator that receives an inquiry from an employee and generates a detailed wage image that includes employee information and employee detailed wage information. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
- d. A purchase simulator that simulates the employee's purchase of a product using a simulation database containing products and product prices of the advertising company. (Col 14, line 45 through Col 15, line 23)

The Valentino reference discloses that the information requested by the employee includes such information related to possible choices in their retirement plans, health insurance plans, and flexible benefit plans such as cafeteria plans. While these choices are enticements to purchase the displayed products, and therefore qualify as advertisements, Valentino does not specifically state that these are advertisements in which data is collected regarding the

success of the promotion and said data is forwarded to the advertisers in a privacy protected manner. However, the analogous art of Kramer (U.S. Patent Number: 6,327,574), discloses that any structured document may be illuminated with advertisements (Col 7, lines 45-53; Figs 3A and 3B). An illumination is a piece of targeted content (Col 4, lines 64-67) whereby sections of documents annotated or replaced with targeted content that expands upon the information in the original content and provides a more interesting presentation of the information (Col 6, lines 23-46) including hyperlinks and promotions (Col 7, lines 8-28). The illumination process described by Kramer processes all personal data on the client side (the terminal used by the user) to maintain privacy (Col 11, line 55 –67) and data regarding the success of the promotion such as the number of views is sent to the advertisers server (Col 13, lines 26-53). Therefore, it would have been obvious to one of ordinary skill in the art to use the targeted advertising disclosed by Kramer with the apparatus for benefit and financial communication disclosed by Valentino. One would have been motivated to include such advertising in order to provide an advertisement revenue stream that helps to offset the expense of operating the system disclosed by Valentino.

Claim 14: Valentino and Kramer disclose the employee information system in claim 13, further comprising a fourth electronic data storage device that stores confirmation information when the employee submits the inquiry and receives the detailed wage image. (Valentino: Col 5, lines 49 – 64: and Col 14, lines 34 – 44)

Claim 15: Valentino and Kramer disclose the employee information system in claim 14, wherein the confirmation information is sent to the second source. (Valentino: Col 5, lines 49 – 64: and Col 14, lines 34 – 44)

Claim 18: Valentino and Kramer disclose the employee information apparatus in claim 13, wherein the advertising information includes information tailored to at least one of an employee income level, an employee organizational unit and an employee information input. (Valentino: Col 14, lines 45 – 65)

Claim 19: Valentino discloses a wage information management apparatus, comprising:

- a. A detailed wage data structure that stores details of an employee's wage. (Col 5, line 66 through Col 6, line 10)
- b. A detailed wage inquiry authenticator that authenticates a wage inquiry based on an authentication code in the wage inquiry. (Col 6, lines 11 – 41)
- c. A communicator that, when the detailed wage authenticator authenticates the wage inquiry, sends the detailed wage data to a source of the wage inquiry. (Col 6, line 49 through Col 7, line 21)
- d. A deduction information collector that accepts a deduction information from the source of the wage inquiry. (Col 14, lines 19 – 44)

- e. A deduction information recorder that records the deduction information sent from the source of the wage inquiry. (Col 14, lines 19 – 44)
- f. A confirmation data structure that generates and stores confirmation information, to be sent to a second source, when the source submits the wage inquiry and the communicator sends the detailed wage data. (Col 5, lines 49 – 64 and Col 14, lines 19 – 44)
- g. A simulation database data structure containing products and product prices of an advertising company used for product purchase simulation. (Col 14, line 45 through Col 15, line 23)

The Valentino reference discloses the generation of storage of confirmation information, he does not specifically state that the confirmation is sent to and advertiser. However, the analogous teachings of Kramer disclose advertiser's providing illuminations on structured documents. The illumination process described by Kramer processes all personal data on the client side (the terminal used by the user) to maintain privacy (Col 11, line 55 –67) and data regarding the success of the promotion such as the number of views (confirmations) is sent to the advertisers server (Col 13, lines 26-53). Therefore, it would have been obvious to one of ordinary skill in the art to use the targeted advertising disclosed by Kramer with the apparatus for benefit and financial communication disclosed by Valentino. One would have been motivated to include such advertising in order to provide an advertisement revenue stream that helps to offset the expense of operating the system disclosed by Valentino.

Claim 22: Valentino discloses an employee information communication apparatus, comprising:

- a. A first electronic data structure that stores employee information including at least one of employee name, employee company, employee number and employee password. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
- b. A third electronic data structure that stores employee detailed wage information including at least one of employee number, employee company, employee name, payment amounts, deduction amounts and date of payment from a second source. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
- c. An image generator that receives an inquiry from an employee and generates a detailed wage image that includes employee information and employee detailed wage information. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
- d. A purchase simulator that simulates the employee's purchase of a product using a simulation database containing products and product prices of the advertising company. (Col 14, line 45 through Col 15, line 23)

The Valentino reference discloses that the information requested by the employee includes such information related to possible choices in their retirement plans, health insurance plans, and flexible benefit plans such as

cafeteria plans. While these choices are enticements to purchase the displayed products, and therefore qualify as advertisements, Valentino does not specifically state that these are advertisements in which data is collected regarding the success of the promotion and said data is forwarded to the advertisers in a privacy protected manner. However, the analogous art of Kramer (U.S. Patent Number: 6,327,574), discloses that any structured document may be illuminated with advertisements (Col 7, lines 45-53; Figs 3A and 3B). An illumination is a piece of targeted content (Col 4, lines 64-67) whereby sections of documents annotated or replaced with targeted content that expands upon the information in the original content and provides a more interesting presentation of the information (Col 6, lines 23-46) including hyperlinks and promotions (Col 7, lines 8-28). The illumination process described by Kramer processes all personal data on the client side (the terminal used by the user) to maintain privacy (Col 11, line 55 –67) and data regarding the success of the promotion such as the number of views is sent to the advertisers server (Col 13, lines 26-53). Therefore, it would have been obvious to one of ordinary skill in the art to use the targeted advertising disclosed by Kramer with the apparatus for benefit and financial communication disclosed by Valentino. One would have been motivated to include such advertising in order to provide an advertisement revenue stream that helps to offset the expense of operating the system disclosed by Valentino.

***Response to Arguments***

4. Applicant's arguments filed September 14, 2007 have been fully considered but they are not persuasive.

a. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Furthermore, the Kramer reference discloses in Col 7, lines 45-53, that the advertisements of Kramer "can be applied to any type of structured document so long as it is formatted with the information describing the selectable content alternatives, in accordance with the present invention, including any type of financial statement generally (e.g. bank statements or stock portfolio statements). As the invention of Valentino, is directed towards a benefit and financial communication service the combination as described is one that is obvious to a person of ordinary skill in the art at the time the invention was made.

b. The applicant argues that the combination would not result in a system that includes "a purchase simulation that simulates the member's purchase of the advertising company's product...and a product promotion analyzer that computes a product promotion result of advertisement the basis of an output of the

purchase". However, at the examiner has asserted when rejecting the independent claims, in the Office Action dated April 16, 2007, Valentino discloses that the information requested by the employee includes such information related to possible choices in their retirement plans, health insurance plans, and flexible benefit plans such as cafeteria plans. These choices are advertisement used to entice employees to purchase the displayed products. Since Valentino further discloses in Col 14, line 45 through Col 15, line 23, the computation of "what if" scenarios regarding the purchase of the various product advertised, the limitations of the claims as currently written have been disclosed.

c. The applicant argues that the examiner has not addressed where the prior art teaches or suggests "an advertisement information file that stores advertising information, said advertising information being sent from an advertising company" or " a product promotion analyzer that computes a product promotion result of advertisement on the basis of an output of the purchase simulator and sends the product promotion result of more than one member in aggregate to the advertising company such that privacy is ensured for more than one member". However, as disclosed when rejecting the independent claims, in the Office Action dated April 16, 2007, Valentino discloses that the information requested by the employee includes such information related to possible choices in their retirement plans, health insurance plans, and flexible benefit plans such as cafeteria plans. These choices are advertisement used to entice employees to purchase the displayed products. Since the Valentino reference discloses



accessing a database to respond to inquiries by the employee in Col 6, line 49 through Col 7, line 21, the advertising information is inherently contained in a "file". Additionally, the Valentino reference discloses generating "what if" scenarios for employees utilizing the system in Col 14, line 45 through Col 15, line 23 which constitute the claimed "purchase simulator". The Kramer reference discloses the privacy and advertisement tracking (product promotion analyzer) feature of the claims in Col 4, lines 64-67; Col 6, lines 23-46; Col 7, lines 8-28; Col 7, lines 45-53; Fig 3A; Fig 3B; Col 11, line 55-67; and Col 13, lines 26-53. Thus the limitations of the claims as currently written are disclosed by the combination of the Valentino reference in view of the Kramer reference.

d. The applicant's amendment requires that the purchase simulator use a simulation database containing products and product prices of the advertising company. The Valentino reference discloses the use of such a database in Col 14, line 45 through Col 15, line 23. Valentino discloses generating "what if" scenarios that "achieve the individually desired level of coverage, while at the same time maximizing savings and minimizing costs and taxes". Therefore, the advertising database containing the possible products the employee can purchase must inherently include the product prices, since the employee is able to see the effects of their selections in relationship to the costs of the selection.

### ***Conclusion***

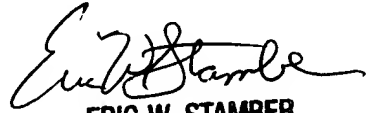
5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*jvb*  
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